



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/542,846 04/23/00 DUKOT

P 31640-159397

EXAMINER

HM12/0917

VENABLE
P.O. BOX 34385
WASHINGTON DC 20043-9998

MCLELLAIN, E

ART UNIT

PAPER NUMBER

1638
DATE MAILED:

09/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/542,546

Applicant(s)

DUHOT ET AL.

Examiner

Elizabeth F. McElwain

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Substitute Specification

A substitute specification including claims is required pursuant to 37 CFR 1.125(a) because the spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 4-6, drawn to a process for inducing synthesis of branched fatty acids in a plant cell, including where DNA encodes a cyclopropane fatty acid synthesis enzyme, classified in class 800, subclass 281, for example.
- II. Claim 2, drawn to a process for inducing synthesis of branched fatty acids in a plant cell, including an extraction step, classified in class 800, subclass 281, for example.

- III. Claim 3, drawn to a process for inducing synthesis of branched fatty acids in a plant cell, including a treatment step, classified in class 800, subclass 276, for example.
- IV. Claims 1, 4, 5 and 7, drawn to a process for inducing synthesis of branched
5 fatty acids in a plant cell, including where DNA encodes a methyl transferase, classified in class 800, subclass 281, for example.
- V. Claim 8, drawn to a process of claim 4 further comprising a gene for SAM synthetase, classified in class 536, subclass 23.2, for example.
- VI. Claims 9-11, drawn to a process for inducing synthesis of branched fatty acids
10 in a plant cell where the enzyme uses a substrate of at least 3 carbons, classified in class 435 subclass 69.1, for example.
- VII. Claims 12, 13 and 17-19, drawn to a recombinant nucleic acid comprising a gene coding for a product which induces synthesis of branched fatty acids, and vectors and plants comprising said DNA, classified in class 536, subclass 23.6,
15 for example.
- VIII. Claim 14, drawn to a recombinant nucleic acid encoding a methyl transferase, classified in class 536, subclass 23.6, for example.
- IX. Claim 15, drawn to a recombinant nucleic acid encoding a malonyl CoA decarboxylase, classified in class 536, subclass 23.6, for example.

- X. Claim 16, drawn to a recombinant nucleic acid comprising a gene coding for a product which induces synthesis of branched fatty acids and further comprising a gene for SAM synthetase, classified in class 536, subclass 23.1, for example.
- XI. Claims 20-21, 23-25 and 29, drawn to a transgenic plant comprising a gene for inducing synthesis of branched fatty acids, classified in class 800, subclass 298, for example.
- XII. Claim 22, drawn to production of branched fatty acids by cell culture, classified in class 435, subclass 70.1, for example.
- XIII. Claims 26-28, drawn to branched fatty acids and a composition comprising them and use, classified in class 426, subclass 601, for example.

The inventions are distinct, each from the other because:

The inventions of Groups I-XIII are distinct products and methods, wherein one is not required by the other. The methods of Groups I-VI and XII differ one from each of the others in requiring different components and method steps, as well as differing in their starting and end-products. In addition, the recombinant nucleic acids and plant products of Groups VII-XI and XIII are each distinct products that differ chemically and structurally and can be used independently from the methods of Groups I-IV and IX, such as for production of the enzymes in a bacterial cell, for example; and are not required by the methods of Groups I-VI and XII, which could use any one of the other nucleic acids. Thus the inventions of Groups I-XIII are

each capable of being separately made, independently used and the patentability of one would not render the other obvious or unpatentable.

5 Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37
10 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37
15 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Tuesday through Friday from 7:30 AM to
20 5:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published
25 in the Official Gazette, 1096 OG 30 (November 15, 1989).

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

5 Elizabeth F. McElwain, Ph.D.
September 13, 2001

ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1600 •

Elizabeth F. McElwain